

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1-2, 20-22, and 40-41 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Objections

On page 2 of the Office Action, the Examiner indicates that claim 2 is objected to for "informalities". In particular, the Examiner states that "the potential multiple data sources . . . are inconsistent with the specific data source as defined in claim 1. In response, Applicants herein amend claims 2 and 22 to recite a single data source that is not inconsistent with the specific data source recited in claim 1. In view of the foregoing remarks and amendments, Applicants request that the claim objection be withdrawn so that claim 2 may issue in a timely manner.

35 U.S.C. § 103(a)

On page 9 of the Office Action, the Examiner rejects claims 1-17 and 21-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,477,264 to Sarbadhikari et al. (hereafter Sarbadhikari) in view of U.S. Patent No. 5,477,264 to Steinberg et al. (hereafter Steinberg). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Sarbadhikari according to the teachings of Steinberg would produce the claimed invention. Applicants submit that Sarbadhikari in combination with Steinberg fail to teach a number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Sarbadhikari nor Steinberg contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §103 rejection as if applied to amended independent claims 1 and 21 which are now amended to recite "*said data source*

being implemented as a computer in a distributed computer network,” and “said ancillary data module performing one or more on-line management procedures regarding said ancillary data files while an active communication path exists from said imaging device to said computer in said distributed computer network,” and “said one or more ancillary data files including one or more image data files that said imaging device combines with said image data to create a new composite image,” which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Sarbadhikari is limited to teaching “an electronic camera for capturing and storing images in a removable storage device which is also preloaded with software for operating the imaging system (see column 2, lines 54-56). In contrast, Applicants affirmatively claim a data source that is “implemented as a computer in a distributed computer network.” Applicants further submit that Sarbadhikari nowhere discloses “performing one or more on-line management procedures regarding said ancillary data files while an active communication path exists from said imaging device to said computer,” as claimed by Applicants.

On page 10 of the Office Action, the Examiner concedes, with regard to the teachings of Sarabadhikari, that “a data source being implemented as a computer in a distributed computer network is not taught.” Applicants concur. The Examiner then points to Steinberg to purportedly remedy these deficiencies in Sarabadhikari. Applicants respectfully disagree with the Examiner’s interpretation of the teachings of Steinberg.

Steinberg teaches a "communication device" that an electronic camera utilizes to send image data over an electronic network to a "remote computerized destination" (see column 1, line 44, through column 3, line 17). Steinberg explicitly refers to the network computer as a "destination" (see FIG. 1). Steinberg nowhere teaches utilizing the network computer as a "data source" for sending data to the camera device, as claimed by Applicants. The data flow described in Steinberg (camera to network) is in the completely opposite direction to the data flow recited by Applicants (network to camera). Applicants therefore submit that Steinberg *teaches away* from their claimed invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987). For at least the foregoing reasons, Applicants respectfully submit that claims 1 and 21 are not unpatentable in light of the cited references.

Regarding the Examiner's rejection of dependent claims 2-17 and 22-37, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-17 and 22-37, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 1-17 and 21-37 are not unpatentable under 35 U.S.C. § 103 over Sarbadhikari in view

of Steinberg, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-17 and 21-37 under 35 U.S.C. § 103.

On page 16 of the Office Action, the Examiner rejects claims 18-20 and 38-41 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of U.S. Patent No. 6,177,957 to Anderson (hereafter Anderson). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 18-20 and 38-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 18-20 and 38-40, so that these claims may issue in a timely manner.

Furthermore, with regard to claims 18 and 38, the Examiner concedes that Sarbadhikari fails to teach an “off-line management procedure including a file descriptor identification procedure” Applicants concur. The Examiner then points to Anderson to purportedly remedy these deficiencies. Anderson is limited to teaching a camera device that accesses “executable files” from a “flash disk”. Applicants therefore submit that neither Anderson, Sarbadhikari, nor Steinberg teach a “data source being implemented as a computer in a distributed computer network,” as claimed by Applicants. Applicants further submit that neither Anderson, Sarbadhikari, nor Steinberg teach “performing one or more on-line management procedures for said ancillary data files while an active communication path exists to said computer in said distributed computer network,” as claimed by Applicants.

Independent claim 41 has been amended herein to recite elements and functionality similar to those recited in claim 21, as discussed above. Applicants therefore incorporate those prior remarks by reference with regard to claim 41. In addition, with regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21, as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully

submit that, in light of the substantial differences between the teachings of the cited references and Applicants' invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of the cited references.

For at least the foregoing reasons, the Applicants submit that claims 18-20 and 38-42 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 18-20 and 38-42 so that these claims may issue in a timely manner.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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